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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,462	08/30/2001	Christopher P. Carey	CE08796R	3246
22917	7590	01/30/2006		
MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			EXAMINER CHOW, MING	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/945,462

Applicant(s)

CAREY ET AL.

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Arguments***

1. In view of the Appeal Brief filed on 11-9-05, PROSECUTION IS HEREBY REOPENED. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Allowable Subject Matter***

2. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach determining a first parameter indicates the first authentication completed successfully. Initiating a call setup before the second authentication procedure has completed. When the second authentication completes successfully,

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continuing the call setup. When the second authentication does not complete successfully, discontinuing the call setup.

### ***Claim Objections***

3. Claim 2 recites “call set setup” (line 7). The claimed is read as “call setup” by the Examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “determining whether to initiate call setup for the mobile station prior to the second authentication procedure completing successfully” is not disclosed by the specification. The current specification disclosed, on line 15-19 page 5, “the MSC/VLR receives parameters for a subsequent operation and GCA was successful, it does not delay call setup. Instead, the MSC/VLR initiates call setup in parallel with initiating the subsequent operation”. The specification does not support “a step of determining whether to initiate call setup”. There is no “determining step” involved. The current application only supports the call setup is in parallel with the second authentication without any step of determining. It is not obvious for one skilled in the art to implement such a “determining step” as such a step requires evaluations of conditions in order to make a determination.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Broyles et al (US: 6665530).

Regarding claims, 1, 5, Broyles et al teach on column 3 line 56 to column 4 line 34, a mobile station sends a first message (RAND and an authentication signature) to the communication network to invoke an authentication procedure at the network.

Broyles et al teach on column 6 line 26 to column 8 line 7, when the first authentication on the network fails, the authentication center sends a message including a unique authentication signature (claimed “first parameter”) generated by the authentication center and a unique challenge security value (claimed “second parameter”) to the MSC (MSC receives the claimed

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“a second message”). The unique challenge security value is transmitted from the MSC to the mobile station for generating a unique authentication signature by the mobile station (reads on claimed “the second parameter associated with a second authentication procedure”). The unique authentication signature (claimed “first parameter”) is generated only when the first authentication on the network fails, therefore, the unique authentication signature (claimed “first parameter”) indicates a status of the first authentication procedure.

Broyle et al teach on column 6 line 26 to column 8 line 7, the mobile station’s access is delayed (reads on claimed “determining not to initiate call setup”) until (claimed “prior to”) the unique challenge authentication is completed successfully. Broyle et al clearly teach “a determining step” which concludes to delay the mobile station’s access until the unique challenge authentication is completed successfully.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broyles et al (US: 6665530) as applied to claim 1 above, and in view of Jung et al (US: 2001/0025345).

Regarding claims, 1, 5, in addition to 35 USC § 102 rejections stated above, Broyles et al teach on column 3 line 56 to column 4 line 34, a mobile station sends a first message (RAND and an authentication signature) to the communication network to invoke an authentication procedure at the network.

Broyles et al teach on column 6 line 26 to column 8 line 7, when the first authentication on the network fails, the authentication center sends a message including a unique authentication signature (claimed “first parameter”) generated by the authentication center and a unique challenge security value (claimed “second parameter”) to the MSC (MSC receives the claimed “a second message”). The unique challenge security value is transmitted from the MSC to the mobile station for generating a unique authentication signature by the mobile station (reads on claimed “the second parameter associated with a second authentication procedure”).

Broyle et al failed to teach “a first parameter indicating a status of the first authentication procedure”. However, June et al teach on section [0058], a parameter indicating the reason of failure (claimed “status”) of the authentication.

Broyle et al teach on column 6 line 26 to column 8 line 7, the mobile station’s access is delayed (reads on claimed “determining not to initiate call setup”) until (claimed “prior to”) the unique challenge authentication is completed successfully. Broyle et al clearly teach “a determining step” which concludes to delay the mobile station’s access until the unique challenge authentication is completed successfully.



It would have been obvious to one skilled at the time the invention was made to modify Broyle et al to have the “a first parameter indicating a status of the first authentication procedure” as taught by Jung et al such that the modified system of Broyle et al would be able to support the system users with a clear message about failure of the first authentication procedure.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broyles et al as applied to claim 1 above, and in view of Jung et al, and further in view of Patel (US: 6591364).

The modified system of Broyle et al in view of Jung et al as stated in claim 1 above failed to teach the “second authentication procedure is an SSD update procedure”. However, Patel teaches on column 2 line 33-43, per IS-41, authentication procedure is an SSD update.

It would have been obvious to one skilled at the time the invention was made to modify Broyle et al in view of Jung et al to have the “second authentication procedure is an SSD update procedure” as taught by Patel such that the modified system of Broyle et al in view of Jung et al would be able to support the system users for further verification by updating the SSD.

### ***Response to Arguments***

8. Applicant's arguments filed on 11/9/05 have been fully considered.

- i) Applicant argues, on pages 7, regarding “determining whether to initiate call setup prior to the second authentication procedure completing successfully”. Broyle et al teach on column 6 line 26 to column 8 line 7, the mobile station’s access is delayed (reads on claimed “determining not to initiate call setup”) until (claimed “prior to”) the unique challenge authentication is completed successfully. Broyle et al clearly teach “a determining step” which concludes to delay the mobile station’s access until the unique challenge authentication is completed successfully.
- ii) Applicant argues, on pages 7, 9, regarding allowability of claim 2. Claim 2 is now indicated as allowable if it is rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 2 claimed “initiating call setup before the second authentication procedure has completed” which is disclosed by the specification.
- iii) Applicant argues, on page 7, regarding allowability of claim 5. Applicant failed to specifically point out the grounds why the cited prior art does not disclose or suggest the claimed limitations. Therefore, the rejections stand.
- iv) Applicant argues, on page 8, 9, regarding allowability of claim 6. Applicant failed to specifically point out the grounds why the cited prior art does not disclose or suggest the claimed limitations. Therefore, the rejections stand.
- v) Applicant argues, on page 8, regarding allowability of claims 1, 5. see responses stated above.

*Conclusion*

9. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- US: 6889328.

10. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (571) 272-7535. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600. Any response to this action should be mailed to:

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**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to Central FAX Number 571-273-8300.**

Patent Examiner

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Ming Chow

**OVIDIO ESCALANTE  
PATENT EXAMINER**

*Ovidio Escalante*